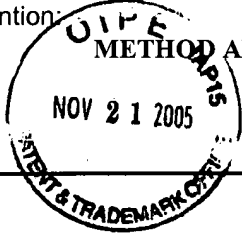


AF / SPW

TRANSMITTAL OF APPEAL BRIEF (Small Entity)					Docket No. 01-033
In Re Application Of: JAY S. WALKER ET AL.					
Application No. 09/973,581	Filing Date October 9, 2001	Examiner Olisa Anwah	Customer No. 22927	Group Art Unit 2645	Confirmation No. 5776
Invention: METHOD AND APPARATUS FOR ENTERTAINING CALLERS IN A QUEUE					



COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

☒ Applicant claims small entity status. See 37 CFR 1.27

The fee for filing this Appeal Brief is: **\$250.00**

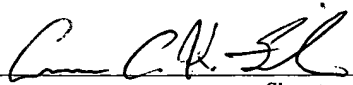
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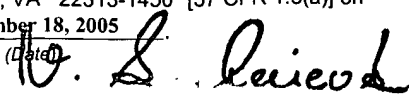
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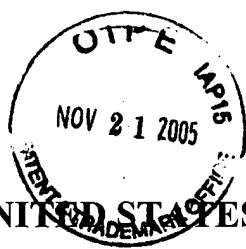
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AP ✓

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants: Jay S. Walker, James A. Jorasch, Tomas M. Sparico, and
Michael D. Downs
Application No.: 09/973,581
Filed: October 9, 2001
Title: METHOD AND APPARATUS FOR ENTERTAINING
CALLERS IN A QUEUE

Attorney Docket No.: 01-033

Group Art Unit: 2645
Examiner: Olisa Anwah

APPEAL BRIEF

**BOARD OF PATENT APPEALS
AND INTERFERENCES**

Mail Stop: Appeal Brief
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Appellants hereby appeal to the Board of Patent Appeals and Interferences
from the decision of the Examiner in the Final Office Action mailed June 7, 2005
(Part of Paper No. / Mail Date 20050523), rejecting claims **1-22**.

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REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, 5 High Ridge Park, Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

No interferences or appeals are known to Appellants, Appellants' legal representative, or assignee that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims **1-22** are pending in the present application.

Claims **17-22** have been allowed.

Claims **1-16** are being appealed.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the Final Office Action mailed June 7, 2005, the rejections of which are being appealed herein.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the independent claims being appealed are provided below. The summaries include sufficient information about the claimed subject matter so that an informed review of the Examiner's adverse determination of patentability can be made.

As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification and Drawings, as appropriate. Any such reference:

- (i) is by way of example of the claimed subject matter only;
- (ii) is to be considered as potentially useful in clarifying the particular subject matter of the particular independent claim being explained (and not other claims or "the invention" as a whole), unless explicitly stated otherwise; and
- (iii) is not to be considered as broadening or narrowing the scope of any recited term from its meaning to one of ordinary skill in the art, unless explicitly stated otherwise.

Of the claims being appealed, claims 1 and 2 are independent.

1. Independent Claim 1

In accordance with one or more embodiments, a method comprises *receiving a call from a caller, the call being associated with a first merchant*. See, for example, Specification, paragraphs [13]; [27]; [29]; [46]; [49]; [58]; [76]; [97]-[98]; [112]; FIG. 10A, reference numerals 1005, 10010; and FIG. 11A, reference numerals 1105, 1110.

The method further provides for *placing the call in a queue for the first merchant*. See, for example, Specification, paragraphs [27]-[28]; [31]; [34]; [37];

[39]; [40]; [42]-[44]; [47]; [64]; [72]; [76]; [84]; [86]-[87]; [89]; [91]-[95]; [97]; [99]; [102]; [108]; [111]; [113]; FIG. 10C, reference numeral 1060; and FIG. 11A, reference numeral 1117.

The method further provides for, *determining a second merchant*. See, for example, Specification, paragraphs [55]; [57]; [63]; [65]-[67]; [78]-[79]; [81]-[82]; [84]; [87]-[89]; [91]; [102]-[103]; [105]; [111]; [115]-[117]; [125]; [128]; FIG. 8; FIG. 9; FIG. 10B, reference numerals 1030, 1042; and FIG. 11A, reference numeral 1127.

The method further provides for, *establishing a connection, the connection enabling the caller to make a purchase from the second merchant while the call remains in the queue for the first merchant*. See, for example, Specification, paragraphs [34]; [37]; [55]-[58]; [65]-[66]; [69]-[70]; [84]; [86]-[87]; [89]; [102]-[103]; [106]; [111]; [117]; [119]; [121]; [125]; [128]; FIG. 7; FIG. 10B, reference numerals 1040, 1050; and FIG. 11B, reference numerals 1140, 1170.

2. Independent Claim 2

In accordance with one or more embodiments, a method comprises *receiving an incoming call from a caller*. See, for example, Specification, paragraphs [13]; [27]; [29]; [46]; [49]; [58]; [76]; [97]-[98]; [112]; FIG. 10A, reference numerals 1005, 10010; and FIG. 11A, reference numerals 1105, 1110.

The method further provides for *placing the incoming call in a queue*. See, for example, Specification, paragraphs [27]-[28]; [31]; [34]; [37]; [39]; [40]; [42]-[44]; [47]; [64]; [72]; [76]; [84]; [86]-[87]; [89]; [91]-[95]; [97]; [99]; [102]; [108]; [111]; [113]; FIG. 10C, reference numeral 1060; and FIG. 11A, reference numeral 1117.

The method further provides for, *determining at least one merchant*. See, for example, Specification, paragraphs [55]; [57]; [63]; [65]-[67]; [78]-[79]; [81]-[82]; [84]; [87]-[89]; [91]; [102]-[103]; [105]; [111]; [115]-[117]; [125]; [128]; FIG. 8; FIG. 9; FIG. 10B, reference numerals 1030, 1042; and FIG. 11A, reference numeral 1127.

The method further provides for, *determining access information associated with the at least one merchant*. See, for example, Specification, paragraphs [48]-[51]; [55]; [62]-[63]; [65]; [67]; [78]-[79]; [82]-[83]; [90]-[91]; [105]; [117]-[120]; [125]; FIG. 6; FIG. 8; and FIG. 10B, reference numeral 1045.

The method further provides for, *establishing a connection based on the access information, the connection enabling the caller to make a purchase from the at least one merchant while the incoming call remains in the queue*. See, for example, Specification, paragraphs [34]; [37]; [55]-[58]; [65]-[66]; [69]-[70]; [84]; [86]-[87]; [89]; [102]-[103]; [106]; [111]; [117]; [119]; [121]; [125]; [128]; FIG. 7; FIG. 10B, reference numerals 1040, 1050; and FIG. 11B, reference numerals 1140, 1170.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims **1-16** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of

- U.S. Patent No. 6,614,783 of Sonesh et al. ("Sonesh" herein); and
- U.S. Patent Application No. 2005/0074108 to Dezonno et al. ("Dezonno" herein).

ARGUMENTS

1. Summary of Arguments

The rejections fail for various reasons.

- All of the rejections fail for failure to establish a *prima facie* case. The Examiner has not provided any factual findings in support of any rejection, has not provided substantial evidence in support of any rejection. Accordingly, without more and according to law, Appellants are entitled to allowance of the claims.
- The rejections under 35 U.S.C. §103(a) fail at least because the rejections for obviousness constitute conclusory statements and unsupported allegations, ignore claim limitations, and are completely devoid of any motivation to combine the references. Further, the references do not, alone or in combination, teach all of the limitations of any claim being appealed and do not provide any motivation to combine the references, even if the combination did result in the claimed combination (which it does not).

Accordingly, the rejections are inappropriate and Appellants respectfully request that the rejections be reversed.

2. Form of Appeal Brief

In the arguments herein, limitations of the claims are indicated in *italics*, claim numbers are indicated in **bold**, and the references of record are indicated by underlining.

In separate arguments of patentability of different Groups of claims, Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants may refer to:

The First Office Action, which was mailed on January 25, 2005 as part of Paper No. / Mail Date 20050120; and

The Final Office Action, which is the office action the rejections of which are being appealed herein, which was mailed on June 7, 2005 as part of Paper No. / Mail Date 20050523.

4. 35 U.S.C. §103 Rejections

Claims **1-16** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Sonesh and Dezonno. Appellants traverse these rejections.

A reading of the rejections reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by any evidence of record. Accordingly, the Examiner has not presented a *prima facie* case of obviousness of any claim.

The Examiner's Section 103(a) rejections based on the above grounds are argued separately for the following groups of appealed claims:

- Claim **1**; and
- Claims **2-16**.

4.1. The Proper Legal Standard under 35 U.S.C. § 103(a)

The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an un rebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. *In re Rouffet*. The secondary considerations are also essential components of the obviousness determination. *In re Rouffet*.

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

When a rejection is based on a combination of references, the Examiner can satisfy the *prima facie* burden only by showing some objective teaching leading to the purported combination of references. *In re Fritch*. Lacking a motivation to combine references, there is no *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. Cardiac Pacemakers v. St. Jude Medical, 381 F.3d 1371, 1376 (Fed. Cir. 2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. In re Grabiak, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Healthcare Corp., 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. McGinley v. Franklin Sports, Inc., 60 U.S.P.Q.2D 1001, 262 F.3d 1339, 1352 (Fed. Cir. 2001). In each case the factual inquiry whether to combine references must be thorough and searching. *Id.*, at 1352-53.

Finally, during examination, claims are given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 54 U.S.P.Q.2D 1664, 211 F.3d 1367 (Fed. Cir. 2000). The "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." *In re Morris*, 44 U.S.P.Q.2D 1023, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

4.2. Substantial evidence is required of all factual findings

In a determination of obviousness, factual findings as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed invention and the prior art, and secondary considerations of nonobviousness must be supported by substantial evidence. *Novamedix Distrib. Ltd. v. Dickinson*, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

"[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Zurko*, 59 U.S.P.Q.2D 1693, 258 F.3d 1379, 1385 (Fed. Cir. 2001); *In re Lee*, 61 U.S.P.Q.2D 1430, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Moreover, where a conclusion of obviousness rests on the prior knowledge in the field of the invention, then that "[p]rior knowledge in the field of the invention must be supported by tangible teachings of reference materials." *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 381 F.3d 1371 (Fed. Cir. 2004).

4.3. Absent substantial evidence, no *prima facie* case exists

To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The initial burden of presenting a *prima facie* case of obviousness is upon the examiner. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 U.S.P.Q.2D 1955, 9 F.3d 1531, 1532 (Fed. Cir. 1993); *Novamedix Distrib. Ltd. v. Dickinson*, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

4.4. Claim 1

Claim 1 stands rejected under Section 103(a) as being unpatentable over Sonesh in view of Dezonno. Claim 1 is independent.

The rejection of claim 1 is flawed at least because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has at least failed to provide substantial evidence for a motivation to combine or modify the references in the manner suggested.
- The references, alone and in combination, fail to teach the claim limitation of *determining a second merchant*.

- The references, alone and in combination, fail to teach the claim limitation of *establishing a connection, the connection enabling the caller to make a purchase from the second merchant while the call remains in the queue for the first merchant*.

4.4.1. No Prima Facie Showing of Obviousness: Claim 1

A reading of the rejection of claim 1 reveals that the motivation to combine the references provided by the Examiner is not supported by evidence and is not directed to how or why the references would have been combined.

Further, even if the motivation to combine the references was proper and supported by the requisite substantial evidence on the records (which Appellants maintain it is not), the references, either alone or in combination, fail to teach limitations of claim 1.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claim 1.

4.4.1.1. No Showing that Claim Limitations Are in References

The Examiner has rejected claim 1 as being unpatentable over Sonesh in view of Dezonno. However, the Examiner has not provided any explanation as to what teaching or suggestion in either of these references, alone or in combination, teaches or suggests the following limitations recited by claim 1:

determining a second merchant, or

establishing a connection, the connection enabling the caller to make a purchase from the second merchant while the call remains in the queue for the first merchant.

Indeed, the Examiner admits that Sonesh fails to teach or suggest either of the above-quoted limitations. Final Office Action, pg. 3, first paragraph. Appellants agree that Sonesh fails to teach or suggest the above-quoted limitations. The Examiner goes on to state, however, that Dezonno discloses these limitations. *Id.* Appellants respectfully disagree with the Examiner's interpretation of the teachings of Dezonno.

Dezonno simply fails to make up for the deficiencies of Sonesh. Dezonno, for example, is directed to Internet sales to customers that do not feel secure inputting their credit card information on-line. Dezonno, Abstract; [0007]-[0008]. Such customers are presented with a "call me now" button that they may press to have an agent call the customer to finish a transaction over the phone (*e.g.*, since it is supposedly more secure). Thus, while Dezonno does initiate a "new" or "second" connection between the merchant and the customer, such a connection is not provided in the context of an "on-hold" option. Nor is such a connection opened with a *second merchant*, as recited in claim 1. Indeed, nowhere does Dezonno teach or suggest *determining a second merchant* (nor does Sonesh, as both references only contemplate a caller queue for a single merchant).

In contrast claim 1 recites the above-quoted limitations that are directed to allowing a customer that is on-hold with a *first merchant* to make purchases from a *second merchant*. In particular, claim 1 recites *determining a second merchant*. In such a manner, for example, an on-hold caller may be directed to a particular merchant to make a purchase. Neither of the cited references contemplates such

functionality. Indeed, neither reference is directed to addressing the entertainment of a customer while on hold.

It is well settled that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” MPEP §2143.03.

Appellants have carefully reviewed both references and fail to find any teaching or suggestion that even remotely suggests the above-quoted limitations of claim 1.

4.4.1.2. No Motivation to Combine Provided

Regarding motivation to combine, as discussed above, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The motivation provided by the Examiner for combining Sonesh and Dezonno is set forth in the following assertion:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sonesh with the merchant of Dezonno...[because] [t]his modification would have improved the convenience of Sonesh by performing transactions via a data network as suggested by Dezonno.

Final Office Action, pg. 3, first paragraph.

This motivation fails for various reasons:

(i) Initially, even if Dezonno suggested “performing transactions via a data network”, it is not at all clear how such a suggestion is related to *determining a second merchant or establishing a connection allowing a caller to make*

purchases from the second merchant. No portion of Dezonno appears to even contemplate such functionality. The Examiner's alleged motivation to combine the references therefore fails to provide any evidence as to *why* combining the references would have been obvious, or *how* such a combination is related to the above-quoted limitations of claim 1. Indeed, "performing transactions via a data network" is not a limitation of claim 1.

(ii) Further, the Examiner has misinterpreted the paragraph of Dezonno cited in support of a motivation to combine the references. Paragraph [0007] of Dezonno, for example, describes how customers are generally reluctant to make purchases via the Internet and therefore utilize telephone-ordering systems. Dezonno describes such a phenomenon as a problem associated with the prior art, of which Dezonno is directed to fixing. In response to such a "problem", Dezonno describes allowing Internet customers to open a "live help" session that will likely reduce reluctance to provide credit card information. Accordingly, the mention of "telephone ordering systems" in paragraph [0007] actually teaches away from combining Dezonno with Sonesh, for Dezonno is directed to solving a problem in a manner that avoids telephone ordering systems. As such, the Examiner's alleged motivation fails to describe why one would have made the proposed combination, and instead actually describes why one would not make the alleged combination.

As discussed above with respect to the applicable law, it is the burden of an examiner to provide in the record relevant findings of fact adequate to show *why* one of ordinary skill in the art would have been motivated to modify a reference in a manner proposed by the examiner. This Examiner, however, has not indicated any reasoning for (much less any evidence of) either (1) *why* one of ordinary skill in the art would have looked to Dezonno based on the teachings of Sonesh, or *vice*

versa; or (2) if there is substantial evidence that Dezonno is somehow relevant to Sonesh (which Appellants dispute), *why*, of all the subject matter discussed in Dezonno, one of ordinary skill in the art would have selected the specific teaching identified by the Examiner to modify the Sonesh system.

For example, the Examiner may provide support for the proposed modification by providing substantial evidence about knowledge of one of ordinary skill in the art or by pointing to a statement in the reference that would have prompted the proposed modification. The statement from Dezonno cited by the Examiner, however, provides no tenable basis for making the Sonesh and Dezonno combination (as described above). The Examiner's above-quoted assertions are completely devoid of any reasoning or fact finding as to *why* one of ordinary skill in the art would have been motivated to make the proposed combination or modifications. The Board is not permitted to accept conclusory findings made by the Examiner that are not supported by any evidence of record. *In re Zurko*, 59 U.S.P.Q.2D 1693, 258 F.3d 1379, 1385 (Fed. Cir. 2001); *In re Lee*, 61 U.S.P.Q.2D 1430, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Thus, in summary, the Examiner has not shown a motivation in the record to modify or combine any of the references of record in any manner that renders claim 1 obvious.

4.4.1.3. No Showing of Level of Ordinary Skill in the Art

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Having failed to resolve the level of

ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine either what “would have been obvious matter of design choice at the time the invention was made” or what references would have been analogous.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claim 1 because the Examiner has not shown (i) that all of the limitations of claim 1 are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claim 1 obvious. Thus, the Section 103(a) rejection of claim 1 should be reversed.

4.4.2. Any Combination of the References Fails to Teach All of the Limitations of claim 1

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Sonesh and Dezonno (which Appellants dispute above), the proposed combination would fail to teach (i) *determining a second merchant*, or (ii) *establishing a connection, the connection enabling the caller to make a purchase from the second merchant while the call remains in the queue for the first merchant*.

Appellants have reviewed each reference and have been unable to find any indication in either reference related to the above-quoted limitations. As described above, the Examiner agrees that none of these limitations can be found in Sonesh, and improperly interprets Dezonno as making up for the deficiencies of Sonesh.

Neither reference, for example, describes *determining a second merchant*. Sonesh does describe callers being on-hold, but does not determine a *second merchant* from which the callers may make purchases while on hold (e.g., while on hold with a *first merchant*). As professed throughout Sonesh, the purpose of Sonesh is to provide “an ACD with the capacity to serve multimedia callers,” See, for example, Sonesh, Col. 2, lines 58-59, to “solve the problem of allowing access to a multimedia ACD via data networks.” Sonesh, Col. 2, lines 61-62. Sonesh does not described, as admitted by the Examiner, determining a *second merchant* or *establishing a connection with the second merchant*.

It should be noted that the embodiments of claim 1 could be practiced in conjunction with the system of Sonesh to allow callers waiting in queues of the Sonesh system to make purchases from *second merchants* (e.g., as determined by the system). In other words, claim 1 may provide advantages that would enhance the Sonesh system (i.e., advantages that Sonesh does not otherwise have).

Dezonno simply fails to make up for the deficiencies of Sonesh. Dezonno, for example, is directed to allowing Internet help seekers to click a button to open up a live session with a help representative. Nowhere does Dezonno describe *determining a second merchant*, for Dezonno is not directed to entertaining callers that are on-hold (e.g., by allowing them to make purchases from a *second merchant*). While Dezonno could be used as a method for allowing callers to connect to the Sonesh system (e.g., a “live help” Internet connection), such a combination would fail to provide the advantages of claim 1, without incorporating the teachings of the present disclosure.

Thus, both Sonesh and Dezonno, alone and in combination, lack any hint or suggestion of the desirability of (i) *determining a second merchant*, or (ii) *establishing a connection, the connection enabling the caller to make a purchase*

from the second merchant while the call remains in the queue for the first merchant.

In summary, the Examiner's proposed combination of the references fails to teach the above-mentioned limitation of claim 1. Further, Appellants assert that any other combination of the references of record also fail to teach or suggest the limitation as claimed. Thus, the Section 103(a) rejection of claim 1 should be reversed.

4.5. Claims 2-16

Claims 2-16 stand rejected under Section 103(a) as being unpatentable over Sonesh in view of Dezonno. Claim 2 is independent, and claims 3-16 are dependent upon claim 2.

The rejections of claims 2-16 are flawed at least because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has at least failed to provide substantial evidence for a motivation to combine or modify the references in the manner suggested.
- The references, alone and in combination, fail to teach the claim limitation of *establishing a connection based on the access information, the connection enabling the caller to make a purchase from the at least one merchant while the incoming call remains in the queue.*

4.5.1. No Prima Facie Showing of Obviousness: Claims 2-16

A reading of the rejections of claims **2-16** reveals that the motivation to combine the references provided by the Examiner is not supported by evidence and is not directed to how or why the references would have been combined.

Further, even if the motivation to combine the references was proper and supported by the requisite substantial evidence on the records (which Appellants maintain it is not), the references, either alone or in combination, fail to teach limitations of claims **2-16**.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claims **2-16**.

4.5.1.1. No Showing that Claim Limitations Are in References

The Examiner has rejected claims **2-16** as being unpatentable over Sonesh in view of Dezonno. However, the Examiner has not provided any explanation as to what teaching or suggestion in either of these references, alone or in combination, teaches or suggests the following limitations recited by claims **2-16**:

establishing a connection based on the access information, the connection enabling the caller to make a purchase from the at least one merchant while the incoming call remains in the queue.

Indeed, the Examiner admits that Sonesh fails to teach or suggest the above-quoted limitation. Final Office Action, pg. 3, last paragraph. Appellants agree that Sonesh fails to teach or suggest the above-quoted limitation. The Examiner goes on to state, however, that Dezonno discloses this limitation. *Id.* Appellants

respectfully disagree with the Examiner's interpretation of the teachings of Dezonno.

Dezonno simply fails to make up for the deficiencies of Sonesh. Dezonno, for example, is directed to Internet sales to customers that do not feel secure inputting their credit card information on-line. Dezonno, Abstract; [0007]-[0008]. Such customers are presented with a "call me now" button that they may press to have an agent call the customer to finish a transaction over the phone (*e.g.*, since it is supposedly more secure). Thus, while Dezonno does initiate a "new" or "second" connection between the merchant and the customer, such a connection is not provided in the context of an "on-hold" option.

In contrast claims 2-16 recite the above-quoted limitation that is directed to allowing a customer that is on-hold to make purchases from a merchant. Neither of the cited references contemplates such functionality. Indeed, neither reference is directed to addressing the entertainment of a customer while on hold.

It is well settled that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." MPEP §2143.03. Appellants have carefully reviewed both references and fail to find any teaching or suggestion that even remotely suggests the above-quoted limitation of claims 2-16.

4.5.1.2. No Motivation to Combine Provided

Regarding motivation to combine, as discussed above, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art. The motivation provided by the Examiner for combining Sonesh and Dezonno is set forth in the following assertion:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sonesh with the merchant of Dezonno...[because] [t]his modification would have improved the convenience of Sonesh by performing transactions via a data network as suggested by Dezonno.

Final Office Action, pg. 4, first paragraph.

This motivation fails for various reasons:

(iii) Initially, even if Dezonno suggested “performing transactions via a data network”, it is not at all clear how such a suggestion is related to *establishing a connection based on the access information, the connection enabling the caller to make a purchase from the at least one merchant while the incoming call remains in the queue*. No portion of Dezonno appears to even contemplate such functionality. The Examiner’s alleged motivation to combine the references therefore fails to provide any evidence as to *why* combining the references would have been obvious, or *how* such a combination is related to the above-quoted limitation of claims **2-16**. Indeed, “performing transactions via a data network” is not a limitation of any of claims **2-16**.

(iv) Further, the Examiner has misinterpreted the paragraph of Dezonno cited in support of a motivation to combine the references. Paragraph [0007] of Dezonno, for example, describes how customers are generally reluctant to make purchases via the Internet and therefore utilize telephone-ordering systems. Dezonno describes such a phenomenon as a problem associated with the prior art, of which Dezonno is directed to fixing. In response to such a “problem”, Dezonno

describes allowing Internet customers to open a “live help” session that will likely reduce reluctance to provide credit card information. Accordingly, the mention of “telephone ordering systems” in paragraph [0007] actually teaches away from combining Dezonno with Sonesh, for Dezonno is directed to solving a problem in a manner that avoids telephone ordering systems. As such, the Examiner’s alleged motivation fails to describe why one would have made the proposed combination, and instead actually describes why one would not make the alleged combination.

As discussed above with respect to the applicable law, it is the burden of an examiner to provide in the record relevant findings of fact adequate to show *why* one of ordinary skill in the art would have been motivated to modify a reference in a manner proposed by the examiner. This Examiner, however, has not indicated any reasoning for (much less any evidence of) either (1) *why* one of ordinary skill in the art would have looked to Dezonno based on the teachings of Sonesh, or *vice versa*; or (2) if there is substantial evidence that Dezonno is somehow relevant to Sonesh (which Appellants dispute), *why*, of all the subject matter discussed in Dezonno, one of ordinary skill in the art would have selected the specific teaching identified by the Examiner to modify the Sonesh system.

For example, the Examiner may provide support for the proposed modification by providing substantial evidence about knowledge of one of ordinary skill in the art or by pointing to a statement in the reference that would have prompted the proposed modification. The statement from Dezonno cited by the Examiner, however, provides no tenable basis for making the Sonesh and Dezonno combination (as described above). The Examiner’s above-quoted assertions are completely devoid of any reasoning or fact finding as to *why* one of ordinary skill in the art would have been motivated to make the proposed

combination or modifications. The Board is not permitted to accept conclusory findings made by the Examiner that are not supported by any evidence of record. In re Zurko, 59 U.S.P.Q.2D 1693, 258 F.3d 1379, 1385 (Fed. Cir. 2001); In re Lee, 61 U.S.P.Q.2D 1430, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Thus, in summary, the Examiner has not shown a motivation in the record to modify or combine any of the references of record in any manner that renders any of claims **2-16** obvious.

4.5.1.3. No Showing of Level of Ordinary Skill in the Art

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine either what “would have been obvious matter of design choice at the time the invention was made” or what references would have been analogous.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to any of claims **2-16** because the Examiner has not shown (i) that all of the limitations of claims **2-16** are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders any of claims **2-16** obvious. Thus, the Section 103(a) rejections of claims **2-16** should be reversed.

4.5.2. Any Combination of the References Fails to Teach All of the Limitations of claims 2-16

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Sonesh and Dezonno (which Appellants dispute above), the proposed combination would fail to teach *establishing a connection based on the access information, the connection enabling the caller to make a purchase from the at least one merchant while the incoming call remains in the queue*.

Appellants have reviewed each reference and have been unable to find any indication in either reference related to the above-quoted limitation. As described above, the Examiner agrees that none of these limitations can be found in Sonesh, and improperly interprets Dezonno as making up for the deficiencies of Sonesh.

It should be noted that the embodiments of claims 2-16 could be practiced in conjunction with the systems of Sonesh and Dezonno. As described above with reference to claim 1, for example, Dezonno could be used as a different method of allowing callers to access the Sonesh system. Embodiments of claims 2-16 could then be utilized to provide callers in the Sonesh queue (*e.g.*, whether they originated using a Dezonno access method, or otherwise) with various options such as being able to make purchases at a merchant while remaining on hold. In other words, claims 2-16 may provide advantages that would enhance the Sonesh and Dezonno systems (*i.e.*, advantages that Sonesh and Dezonno do not otherwise have).

Thus, both Sonesh and Dezonno, alone and in combination, lack any hint or suggestion of the desirability of *establishing a connection based on the access*

information, the connection enabling the caller to make a purchase from the at least one merchant while the incoming call remains in the queue.

In summary, the Examiner's proposed combination of the references fails to teach the above-mentioned limitation of claims **2-16**. Further, Appellants assert that any other combination of the references of record also fail to teach or suggest the limitation as claimed. Thus, the Section 103(a) rejections of claims **2-16** should be reversed.

CONCLUSION

Thus, the Examiner's rejections of the pending claims are improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Carson C.K. Fincham using the information provided below.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

November 18, 2005
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APPENDIX A - CLAIMS INVOLVED IN THE APPEAL

1. A method comprising:
receiving a call from a caller, the call being associated with a first merchant;
placing the call in a queue for the first merchant;
determining a second merchant; and
establishing a connection, the connection enabling the caller to make a purchase from the second merchant while the call remains in the queue for the first merchant.

2. A method comprising:
receiving an incoming call from a caller;
placing the incoming call in a queue;
determining at least one merchant;
determining access information associated with the at least one merchant;
and
establishing a connection based on the access information, the connection enabling the caller to make a purchase from the at least one merchant while the incoming call remains in the queue.

3. The method of claim 2, further comprising:
transferring the incoming call to an attendant.

4. The method of claim 2, further comprising:
providing to the caller an indication of a plurality of entertainment options.

5. The method of claim 4, further comprising:
receiving from the caller an indication of at least one entertainment option.
6. The method of claim 2, in which determining the at least one merchant comprises:
providing to the caller an indication of a plurality of merchants; and
receiving from the caller an indication of the at least one merchant.
7. The method of claim 2, further comprising:
determining information that is associated with the incoming call.
8. The method of claim 7, in which determining the information that is associated with the incoming call comprises:
receiving the information that is associated with the incoming call from the caller.
9. The method of claim 7, in which determining the information that is associated with the incoming call comprises:
retrieving the information that is associated with the incoming call from a record of a database, in which the record is associated with the caller.
10. The method of claim 7, in which determining the information that is associated with the incoming call comprises:
retrieving the information that is associated with the incoming call from a record of a database, in which the record is associated with the incoming call.

11. The method of claim 7, further comprising:
providing to the caller an indication of a plurality of entertainment options
based on the information that is associated with the incoming call.

12. The method of claim 7, further comprising:
providing to the caller an indication of the at least one merchant based on the
information that is associated with the incoming call.

13. The method of claim 7, in which determining the at least one
merchant comprises:
determining the at least one merchant based on the information that is
associated with the incoming call.

14. The method of claim 7, in which determining the at least one
merchant comprises:
determining a plurality of merchants based on the information that is
associated with the incoming call;
providing to the caller an indication of the plurality of merchants; and
receiving from the caller an indication of the at least one merchant.

15. The method of claim 7, in which the information that is associated
with the incoming call comprises at least one of:
a time the incoming call was received,
a time the incoming call has been on hold,
an indication of a category of the incoming call,
a name of the caller,

an identifier that identifies the caller,
a telephone number associated with the caller,
an address associated with the caller,
data indicating at least one purchase associated with the caller,
data indicating at least one reservation associated with the caller,
an indication of an area of expertise of the caller,
an indication of a rate charged for expertise of the caller, and
an account identifier that identifies a financial account associated with the caller.

16. The method of claim 2, in which the access information comprises at least one of:

a uniform resource locator (URL),
a telephone number,
a discount identifier that identifies a discount,
a promotional code,
a digital certificate,
an account number, and
a password.

APPENDIX B – EVIDENCE

<NONE>

APPENDIX C – RELATED PROCEEDINGS

<NONE>